

Remarks

Reconsideration and withdrawal of the objections and rejections of the claims, in view of the amendments and remarks herein, is respectfully requested. Claims 1, 8-9, 15, 17-18, and 25 are amended. The amendments are intended to advance the application and are not intended to concede to the correctness of the Examiner's position or to prejudice the prosecution of the claims prior to amendment, which claims are in a continuation of the present application. Claims 1 to 43 are pending.

In response to the finality of the Restriction Requirement, Applicant reserves the right to petition the Commissioner to review the Restriction Requirement.

The Examiner objected to claims 15-18 and 25 for being drawn to non-elected claims. Claims 15, 17, 18 and 25 are amended to depend from at least one of the elected claims. Therefore, the Examiner is respectfully requested to withdraw the objection to claims 15-18 and 25.

The 35 U.S.C § 112 Rejections

The Examiner rejected claims 1, 8-9, 15-19, 23, and 25-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection, as it may be maintained with respect to the pending claims, is respectfully traversed.

Specifically, the Examiner asserts that the claims encompass currently unidentified portions of *vanA*-specific probes, and that the specification fails to disclose specific portions and to place any structural, chemical or functional limitations on the portions of those probes.

The Examiner is respectfully reminded that Applicant need not teach what is well known to the art. *vanA* sequences, including *vanA*-specific probes and primers, were well known to the art, as were amplification and hybridization assays to detect those sequences (see Petrich et al., Mol. Cell Probes, 13:275 (1999)) and U.S. Patent No. 6,274,316, both cited against the claims under 35 U.S.C § 102(b)).

Moreover, Applicant's specification clearly identifies the nucleotide sequence corresponding to nucleotides 870 to 896, 851 to 868 and 898 to 917 of *vanA* (see Figure 1 and SEQ ID NOS. 2-4). Further, the probe recited in claim 1 hybridizes to amplified *vanA* nucleic

acid under high stringency hybridization conditions. Accordingly, the recited portions of *vanA*-specific probes have a common structure and function.

Therefore, withdrawal of the 35 U.S.C. § 112, first paragraph, written description rejection is respectfully requested.

The Examiner also rejected claims 1, 8-9, 15-19, 23, and 25-26 under 35 U.S.C. § 112, second paragraph, asserting that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

In particular, the Examiner asserts that: a) the claims do not include a step correlating the detection of *vanA* in a sample with detection of hybrid formation, b) the claims do not recite a reference sequence upon which the nucleotide fragments are based, c) the claims do not refer to a sequence identifier number, and d) the phrase "high stringency" is indefinite.

The amendments to claim 1 to recite "SEQ ID NO:2", "SEQ ID NO"3" and "SEQ ID NO:4" obviate bases b) and c) of the 35 U.S.C. § 112, second paragraph, rejection.

With regard to basis a) of the rejection, the Examiner is requested to consider that the hybrids that are detected are those between amplified *vanA* nucleic acid from a sample and a *vanA*-specific probe. Therefore, the claims are directed to a method to detect *vanA* nucleic acid in a sample.

It is Applicant's position that the phrase "high stringency" is conventionally used in the art. Even if, assuming for the sake of argument, the metes and bounds of the phrase "high stringency" were not readily recognizable to one skilled in the art, the specification discloses high stringency conditions at page 20, lines 19-25 and page 25, lines 18-24. Thus, the scope of the claims would be clear to a person of skilled in the art, particularly when read in light of the specification.

Therefore, withdrawal of the 35 U.S.C. § 112, second paragraph, rejections is respectfully requested.

The 35 U.S.C § 102 Rejections

The Examiner rejected claims 1, 8-9, 15-18, 23, and 25 under 35 U.S.C. § 102(b) as being anticipated by Petrich et al. (Mol. Cell Probes, 13:275 (1999)). The Examiner also rejected claims 1, 8-9, 15-19, 23, and 25-26 under 35 U.S.C. § 102(b) as being anticipated by Modrusan (U.S. Patent No. 6,274,316). These rejections are respectfully traversed.

Petrich et al. disclose 3 *vanA* specific sequences: primer *vanA1*, which has sequences corresponding to nucleotides 738-757 in the *vanA* sequence in NCBI Accession No. X56895, primer *vanA2*, which has sequences corresponding to nucleotides 1285-1367 in the *vanA* sequence in NCBI Accession No. X56895, and probe *vanA3*, which has sequences corresponding to nucleotides 941 to 957 in the *vanA* sequence in NCBI Accession No. X56895.

Modrusan disclose 7 *vanA* specific sequences: vanA811L-27 (column 12, lines 5-7) and vanA811L-27T (column 12, lines 8-10), each of which has sequences corresponding to nucleotides 811 to 837 of X56895; vanA813L-25 and vanA812L-25 (column 12, lines 37-42), each of which has sequences corresponding to nucleotides 813 to 837 of X56895; vanA1117-21 and vanA1121-17 (column 12, lines 43-44), each of which has sequences corresponding to nucleotides 1117 to 1137 of X56895; and vanA1005-22 (column 13, lines 26-27), which has sequences corresponding to nucleotides 1005 to 1026 of X56895.

Neither Petrich et al. nor Modrusan discloses a *vanA*-specific probe that includes sequences substantially corresponding to nucleotides 870 to 896, 851 to 868, and 898 to 917 of the *vanA* gene, the complement of those sequences, or portions of those sequences.

Accordingly, withdrawal of the 35 U.S.C. § 102(b) rejections is appropriate and respectfully requested.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6959 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KIRSTY JANE DODGSON

By her Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6959

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By Janet E. Embretson

Janet E. Embretson
Reg. No. 39,665

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This paper or fee is being filed on the date indicated above using the USPTO's electronic filing system EFS-Web, and is addressed to: The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name

CANDIS BUENDING

Signature

Candis Buending